

P19296.P09



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Intellectual Property Causes
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Attorney Docket No. P19296

In re application of : Dr. J. C. KÄRGER et al.

Serial No. : 09/585,568

Group Art Unit: 3726

Filed : June 2, 2000

Examiner: M. Jimenez

For : ELASTIC ROLLER AND PROCESS FOR PRODUCING SAME

THE COMMISSIONER OF PATENTS AND TRADEMARKS
 Washington, D.C. 20231

Sir:

Transmitted herewith is a Response To Restriction Requirement with Traverse in the above-captioned application.

- ☐ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a verified statement previously filed.
- ☐ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.
- ☐ A Request for Extension of Time.
- ☒ No additional fee is required.

The fee has been calculated as shown below:

| Claims After Amendment | No. Claims Previously Paid For | Present Extra | Small Entity | | Other Than A Small Entity | |
|-------------------------------------|--------------------------------|---------------|--------------|-----|---------------------------|--------|
| | | | Rate | Fee | Rate | Fee |
| Total Claims:60 | *60 | 0 | x 9= | \$ | x 18= | \$0.00 |
| Indep. Claims:2 | **3 | 0 | x 42= | \$ | x 84= | \$0.00 |
| Multiple Dependent Claims Presented | | | +140= | \$ | +280= | \$0.00 |
| Extension Fees for Month | | | | \$ | | \$0.00 |
| Total: | | | | \$ | Total: | \$0.00 |

*If less than 20, write 20

**If less than 3, write 3

☐ Please charge my Deposit Account No. 19-0089 in the amount of \$_____.N/A A Check in the amount of \$_____ to cover the filing/extension fee is included.☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.☒ Any additional filing fees required under 37 C.F.R. 1.16.☒ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 CFR 1.136) (a)(3)

Neil F. Greenblum
 Neil F. Greenblum
 Reg. No. 28,394

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Dr. J.C. KÄRGER et al.

Appln. No. : 09/585,568

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For : ELASTIC ROLLER AND PROCESS FOR PRODUCING SAME

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RESPONSE TO RESTRICTION REQUIREMENT WITH TRAVERSE

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

In response to the Examiner's restriction requirement of September 10, 2001, the time set for response being set one month from the mailing date from the U.S. Patent and Trademark Office, i.e., October 10, 2001, Applicants hereby elect the invention of Group I, including claims 1 - 41. Moreover, Applicants elect species C, which the Examiner indicates is directed to claims 11 - 20, 23, 38, and 41. Moreover, Applicants note that at least claims 1 - 3, 21, 22, 24 - 36, and 39 are generic. The above elections are made with traverse for the reasons set herein below:

In the Official Action of September 10, 2001, the Examiner indicated that all claims (1 - 60) were subject to restriction under 35 U.S.C. § 121. The Examiner restricted the claimed invention into a Group I, including claims 1 - 41, drawn to an elastic roller, classified in class 492, subclass 50 and a Group II, including claims 42 - 60, drawn to a process for producing an elastic roll, classified in class 29, subclass 895.

The Examiner asserted that the inventions were related as process of making and product made, and that the inventions are distinct from each other under M.P.E.P. § 806.05(f) because the "process can be used to make a roll without fillers imbedded in the matrix material."

In addition to the restriction requirement, the Examiner has required an election of one of the following species if the invention of Group I is elected:

Species A -- claims 4 - 6;

Species B -- claims 7 - 10, 37, and 40; and

Species C -- claims 11 - 20, 23, 38, and 41.

However, the Examiner has required an election of one of the following species if the invention of Group II is elected:

Species D -- claim 44;

Species E -- claims 45 - 54, 57, and 60; and

Species F -- claims 56 and 59.

Applicants note that, as independent claim 42 recites, *inter alia*, combining at least one metallic filler into an elastic matrix material, the Examiner's assertions that the process can be used to make a roll without fillers imbedded in the matrix material is not well taken. That is, the process recites that the filler is combined *into* the elastic matrix material. Thus, Applicants submit that the Examiner's showing of distinctiveness is improper and should be withdrawn.

Further, Applicants respectfully submit that the Examiner has omitted one of the two criteria for a proper restriction requirement now established by the U.S. Patent and Trademark Office policy. That is, as set forth in M.P.E.P. § 803, "an appropriate explanation" must be advanced by the Examiner as to the existence of a "serious burden" if the restriction requirement were not required.

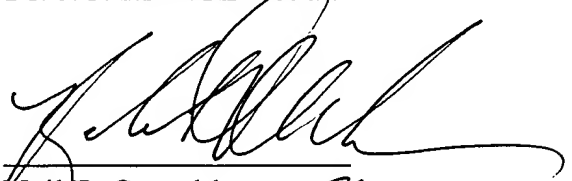
While the Examiner has alleged a possible distinction between the two identified groups of invention, the Examiner has not shown that a concurrent examination of these groups would present a "serious burden" on the Examiner. In fact, while the Examiner has noted that the individual groups would be classified in different classes, there is no appropriate statement that the search areas required to examine the invention of group I would not overlap into the search areas for examining the invention of group II, and vice versa. Applicants respectfully submit that the search for the combination of features recited in the claims of the above-noted groups and the individual species, if not totally co-extensive, would appear to have a very substantial degree of overlap.


Because the search for each group and species of invention is substantially the same, Applicants submit that no undue or serious burden would be presented in concurrently examining Groups I and II and species A - F. Thus, for the above-noted reasons, and consistent with the office policy set forth above in M.P.E.P. § 803, Applicants respectfully request that the Examiner reconsider and withdraw the restriction and species requirement in this application.

For all of the above reasons, the Examiner's restriction is believed to be improper. Nevertheless, Applicants have elected, with traverse, the invention defined by Group I and species C, i.e., claims 11 - 20, 23, 38, and 41. Moreover, Applicants note that at least claims 1 - 3, 21, 22, 24 - 36, and 39 are generic, in the event that the Examiner chooses not to reconsider and withdraw the restriction or species requirement.

Should the Examiner have any questions or comments, he is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,
Dr. J.C. KÄRGER et al.



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October 10, 2001
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